

This Opinion is not a
Precedent of the TTAB

Mailed: March 11, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

—
Westguard Insurance Company

v.

Hanover Stone Partners, LLC

—
Opposition No. 91234475

—
Jeffrey H. Kaufman and Neil D. Greenstein of Techmark Greenstein Law PC for
Westguard Insurance Company.

John A. Mattoon of Ford Marrin Esposito Witmeyer & Gleser LLP for Hanover
Stone Partners, LLC.

—
Before Adlin, Goodman and Allard,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Hanover Stone Partners, LLC (“Applicant”) filed an application to register the
mark WORKERSCOMP GUARD (standard characters, “workerscomp” disclaimed)
for the following services: “Providing information in the field of workers’
compensation; Providing information regarding workers’ compensation insurance

policy rates; Insurance consulting in the field of workers' compensation insurance; Advising clients with respect to the purchase and cost of workers' compensation insurance; Advising clients with respect to claims administration in the field of workers' compensation insurance" in International Class 36.¹

Westguard Insurance Company ("Opposer") opposes registration of Applicant's mark on the ground of likelihood of confusion. Opposer has pleaded ownership of the following registered marks, NOO ¶ 3, 1 TTABVUE:²

- WESTGUARD (typed drawing)³ for "Insurance services, namely, the underwriting of workers' compensation insurance" in International Class 36;⁴

¹ Application Serial No. 87142642 was filed on August 18, 2016 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

² Opposer submitted, as exhibits, TSDR (trademark status and document retrieval) printouts of all pleaded registrations with its notice of opposition, making them of record. NOO, 1 TTABVUE. See Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1). Opposer pleaded three additional registrations, Registration Nos. 1614207 and 3634219 both for the mark GUARD INSURANCE GROUP and design and Registration No. 4752430 for the mark BIZGUARD PLUS COMP · BUSINESS OWNER'S · AUTO · UMBRELLA and design, but these registrations have cancelled under Trademark Act Section 8, 15 U.S.C. § 1058.

When a Federal registration owned by a party has been properly made of record in an inter partes proceeding, and there are changes in the status of the registration between the time it was made of record and the time the case is decided, the Board, in deciding the case, will take judicial notice of, and rely upon, the current status of the registration, as shown by the records of the Office. *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144, 146 (TTAB 1979); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 704.03(b)(1)(A) (2021).

Opposer may rely on whatever common law rights it has in these marks.

References to the record and the parties' briefs refer to the Board's TTABVUE docket system.

³ Effective November 2, 2003, Trademark Rule 2.52, 37 C.F.R. § 2.52, was amended to replace the term "typed" drawing with "standard character" drawing. A mark depicted as a typed drawing is the legal equivalent of a standard character mark. *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1236 n.5 (TTAB 2015) (citing TBMP § 807.03(i)).

⁴ Registration No. 2944719; renewed.

- WESTGUARD (standard characters) for “Insurance services, namely, the underwriting of workers’ compensation, property and casualty insurance, including commercial auto, business owners’ policies and umbrella coverage” in International Class 36⁵ and
- BIZGUARD PLUS (standard characters) for “Underwriting services for property, casualty, accident and health insurance, excluding insurance underwriting in the field of professional liability and directors and officers liability” in International Class 36.⁶

Opposer also pleads common law rights to a “GUARD trademark” and alleges prior use of “GUARD, GUARD INSURANCE GROUP & Design, BIZGUARD PLUS, and WESTGUARD” in connection with “insurance services and other related services.” NOO ¶¶ 2, 4, 1 TTABVUE.

Applicant filed an answer denying the salient allegations in the notice of opposition and asserted defenses.⁷ 4 TTABVUE.

The parties filed trial briefs and Opposer filed a reply brief and corrected reply brief. 45, 46, 47 and 48 TTABVUE.

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the involved application.

⁵ Registration No. 4799970; Section 8 accepted and Section 15 acknowledged.

⁶ Registration No. 4063797; Section 8 accepted and Section 15 acknowledged.

⁷ All defenses have been waived as they were not pursued at trial nor argued in the brief. *Syndicat Des Proprietaires Viticulteurs De Chateauneuf v. Pasquier DesVignes*, 107 USPQ2d 1930, 1931 n.6 (TTAB 2013) (affirmative defenses neither pursued at trial nor argued in brief waived).

In addition, Opposer introduced a notice of reliance upon Internet website evidence, third-party publications and articles, the pleaded⁸ and six unpleaded registrations, 35 TTABVUE, and the declaration testimony of Elizabeth Hartman, Vice President of Marketing for Berkshire Hathaway GUARD Insurance Companies, and accompanying exhibits⁹ (“Hartmann declaration”), 33 TTABVUE with confidential exhibit D at 34 TTABVUE.

Applicant introduced a notice of reliance upon Internet website evidence and submitted a copy of its application file.¹⁰ 39 TTABVUE.

II. Implied Consent/Evidentiary Issues

The following issues listed below are unpleaded, but we consider whether these matters have been tried by implied consent.

Implied consent has been found when a party does not object to the submission of evidence and/or argues the evidence in its brief on the case. *See Miller Law Group, P.C. v. Miller*, 105 USPQ2d 1615, 1623 n.17(TTAB 2013) (unpleaded claim raised at trial and argued in the briefs deemed tried by implied consent); *Time Warner Entm’t*

⁸ Opposer re-submitted TSDR printouts of five out of six of its pleaded registrations under its notice of reliance, two of which are cancelled (Reg. Nos. 1614207 and 4752430), see n.2. Opposer witness also submitted copies of these registrations as exhibits to the Hartman declaration. Opposer’s status and title copies of these cancelled registrations are evidence only that the registrations issued; they are not evidence of any presently existing rights in the marks shown in the registrations. *See Time Warner Entertainment Company v. Jones*, 65 USPQ2d 1650, 1654 n.6 (TTAB 2002).

⁹ The exhibits in the notice of reliance (A-C, E-H, J-K) are duplicative with those attached to the Hartman declaration (A-N). Suffice it to say, the probative value of the documentary evidence does not increase with repetition.

¹⁰ The Interlocutory Attorney struck pages 11 and 12 of Applicant’s notice of reliance. Order on Opposer’s motion to strike Applicant’s notice of reliance. 44 TTABVUE. As noted in the order, the submission of the application file was unnecessary.

Co. v. Jones, 65 USPQ2d at 1653 n.2 (unpleaded registrations tried by implied consent where “applicant has raised no objection to opposer’s submission of and reliance upon these unpleaded registrations”).

A. Unpleaded registrations, common law marks, and trade name use

As indicated, Opposer made of record six unpleaded registrations under notice of reliance and provided testimony regarding the same:

- Registration No. 1392605 for the mark AMGUARD INSURANCE COMPANY (typed drawing, “insurance company” disclaimed) for “insurance services - namely, the underwriting of property and casualty insurance” in International Class 36. Opposer’s notice of reliance 35 TTABVUE 120-128; Hartman declaration ¶ 17 and exhibit G, 33 TTABVUE 6-7, 162-170.
- Registration No. 1559254 for the mark NORGUARD INSURANCE COMPANY (typed drawing, “insurance company” disclaimed) for “insurance services - namely, the underwriting of casualty insurance” in International Class 36. Opposer’s notice of reliance 35 TTABVUE 129-136; Hartman declaration ¶ 17 and exhibit G, 33 TTABVUE 6-7, 171-178.
- Registration No. 2890017 for the mark GUARD E-Z RATE (typed drawing, “rate” disclaimed) for “providing price quotations to insurance agents via the internet” in International Class 36; “providing temporary use of non-downloadable computer software for insurance agents to determine pricing of insurance policy” in International Class 42. Opposer’s notice of reliance 35 TTABVUE 148-156; Hartman declaration ¶ 17 and exhibit G, 33 TTABVUE 6-7, 190-198.
- Registration No. 3385994 for the mark GUARDCO for “Managed care services, namely, electronic processing of health care information; Managed care services, namely, utilization review and pre-certification services” in International Class 35; and “Managed health care services” in International Class 44. Opposer’s notice of reliance 35 TTABVUE at 168-175; Hartman declaration ¶ 17 and exhibit G, 33 TTABVUE 6-7, 210-217.
- Registration No. 3634217 for the mark AMGUARD INSURANCE CO. (standard characters “insurance co.” disclaimed) for “Insurance services, namely, the underwriting of workers’ compensation, property and casualty insurance, including commercial auto, business owners’ policies and umbrella

coverage.” Opposer’s notice of reliance 35 TTABVUE 176-180; Hartman declaration ¶ 17 and exhibit G, 33 TTABVUE 6-7, 218-222.

- Registration No. 3668548 for the mark EASTGUARD INSURANCE COMPANY (standard characters, “insurance company” disclaimed) for “Insurance services, namely, the underwriting of workers’ compensation, property and casualty insurance, including commercial auto, business owners’ policies and umbrella coverage” in International Class 36. Opposer’s notice of reliance 35 TTABVUE 181-185; Hartman declaration ¶ 17 and exhibit G, 33 TTABVUE 6-7, 223-227.

Opposer’s witness testified about common law use of the following unpleaded marks in connection with insurance services: GUARD E-Z RATE, AMGUARD INSURANCE COMPANY, EASTGUARD INSURANCE COMPANY, and NORGUARD INSURANCE COMPANY. Hartman declaration ¶ 16, 33 TTABVUE 5.

Opposer’s witness also testified about the following unpleaded trade name use: AmGUARD Enterprises, The GUARD Network, GUARD Insurance Company, Berkshire Hathaway GUARD Insurance Companies, and the shortened form of the trade name GUARD.¹¹ Hartman declaration ¶ 9, 33 TTABVUE 3-4.

Applicant did not object to Opposer’s introduction of the six unpleaded registrations nor to Opposer’s witness testimony about them. Similarly, Applicant did not object to Opposer’s witness testimony and evidence relating to its common law use of various unpleaded common law marks or its unpleaded trade name use.

Applicant argued in its Trial Brief that the GUARD portion of Opposer’s marks is weak and acknowledged that all of Opposer’s marks include the term GUARD.

¹¹ Opposer Westguard Insurance Company is a wholly owned subsidiary of National Indemnity Company, which is a wholly owned subsidiary of Berkshire Hathaway Guard Insurance Companies. Hartman declaration ¶ 2, 33 TTABVUE 2.

In view of the foregoing, and because Applicant clearly was apprised that Opposer was offering evidence as to unpleaded registrations, unpleaded common law marks and unpleaded trade name use, we find that Applicant has impliedly consented to the trial of these issues. We deem the notice of opposition to be amended to include the unpleaded registrations, common law marks, and the trade name use. *See Fed. R. Civ. P. 15(b).*

B. Family of marks

Opposer's witness testified about prior use of its marks sharing the term GUARD with a descriptive element as a "distinctive naming strategy." Hartman declaration ¶ 20, 33 TTABVUE 7. Its marketing material focuses on the term GUARD, and its GUARD marks are recognized by the public. Hartman declaration ¶¶ 18-20, 23, 33 TTABVUE 7. We consider this witness testimony and accompanying exhibits to be presenting an unpleaded family of marks argument.

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. An "opposer relying on a family of marks is relying on common law rights in the alleged family." *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *7 (TTAB 2020).

We find the family of marks issue was tried by implied consent as Applicant did not object to the testimony, evidence, or argument. *See e.g., Time Warner Entm't Co. v. Jones*, 65 USPQ2d at 1653 n.2 (unpleaded registrations deemed tried by implied

consent where opposing party did not object). We deem the notice of opposition amended to include a family of marks claim.

C. Evidentiary Objections

Opposer objects in its corrected reply brief to any references to “any additional evidence” outside the record that “Applicant has tried to introduce ... whether through inference or suggestion.” 48 TTABVUE 7.

Opposer’s objection is unnecessary, since “factual statements made in a party’s brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial.” TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 704.06(b) (2021). *See Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (agreeing with the Board that factual statements made in a brief are not evidence introduced at trial). Because the Board is fully capable of determining whether factual statements made by Applicant are supported by record evidence, we overrule this objection.

Opposer objects to Applicant’s website evidence submitted under notice of reliance as hearsay. 48 TTABVUE 7.

To the extent Applicant is relying on this website evidence for the truth of the matter, we sustain this objection. However, we may consider this website evidence for what it shows on its face. *Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc.*, 2020 USPQ2d 48324, at *2 (TTAB 2020) (Internet printouts and other materials properly introduced under a notice of reliance without supporting testimony considered only for what they show on their face rather than for the truth of the matters asserted).

III. Statutory Entitlement to Bring an Opposition

In every inter partes case, the plaintiff must establish its statutory entitlement to bring the proceeding. To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute; and (ii) proximate causation. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4 (Fed. Cir. 2020), *cert. denied, sub. nom.*, 141 S. Ct. 2671 (2021). Demonstrating a real interest in opposing registration of a mark satisfies the zone-of-interests requirement, and demonstrating a reasonable belief in damage by the registration of a mark demonstrates damage proximately caused by registration of the mark. *Id.* at 7-8.

Opposer has provided TSDR printouts of its unexpired pleaded registrations as exhibits attached to the notice of opposition, showing Opposer's ownership and their status and title. NOO, 1 TTABVUE. The additional pleaded registrations for which the notice of opposition has been amended also were introduced as TSDR printouts showing Opposer's ownership and their status and title. Hartman Declaration ¶ 17 and exhibit G, 33 TTABVUE 6-7, 162-178, 190-198, 210-222.

These valid and subsisting pleaded registrations establish Opposer's direct commercial interest in the proceeding and reasonable belief in damage. *Herbko Int'l v. Kappa Books*, 308 F.3d 1156, 64 USPQ2d 1375, 1377 (Fed. Cir. 2002) ("In most settings, a direct commercial interest satisfies the 'real interest' test."); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (pleaded

registrations “suffice to establish ...direct commercial interest”; a belief in likely damage can be shown by establishing a direct commercial interest).

Opposer has established it has an interest falling within the zone of interests protected by the statute and a reasonable basis for its belief of damage proximately caused by registration of the mark. Therefore, Opposer has established its entitlement to a statutory cause of action. *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020) *cert. denied, sub. nom.*, 142 S. Ct. 211 (2021); *Cunningham*, 55 USPQ2d at 1844.

IV. Priority

A. Registrations

Because Applicant has not counterclaimed to cancel Opposer’s pleaded registrations, priority is not in issue in this case with respect to the marks and services identified therein. *King Candy, Inc. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Those registrations are as follows: Registration No. 1392605 AMGUARD INSURANCE COMPANY; Registration No. 1559254 NORGUARD INSURANCE COMPANY; Registration No. 2890017 GUARD E-Z RATE; Registration No. 3385994 GUARDCO; Registration No. 3634217 AMGUARD INSURANCE CO.; Registration No. 3668548 EASTGUARD INSURANCE COMPANY; Registration No. 294471 WESTGUARD; Registration No. 4799970 WESTGUARD; and Registration No. 4063797 BIZGUARD PLUS.

Applicant has not submitted any evidence as to the dates of use of its mark, so the earliest date on which it is entitled to rely is the filing date of its application, August 18, 2016. *See Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009) (“applicant may rely without further proof upon the filing date of its application as a ‘constructive use’ date for purposes of priority”); *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991) (“[T]here can be no doubt but that the right to rely upon the constructive use date comes into existence with the filing of the intent-to-use application and that an intent-to-use applicant can rely upon this date in an opposition brought by a third party asserting common law rights”).

B. Common law rights and trade name use

As indicated, Opposer also relies on its rights acquired through use prior to Applicant’s August 18, 2016 priority date.

To prevail on a claim of likelihood of confusion based on prior common law rights in a mark, the mark must be distinctive, inherently or through acquired distinctiveness. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 44-45 (CCPA 1981).

To claim prior trade name use, Opposer must at least have a superior right in the trade name. *See Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 57 USPQ2d 1720, 1723 (Fed. Cir. 2001) (“[T]rade identity rights arise when the term is distinctive, either inherently or through the acquisition of secondary meaning.”).

Applicant has not raised an issue as to the distinctiveness of Opposer's composite marks, which we therefore find distinctive. *See Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1634 (TTAB 2007) (Board found ARDEN B. distinctive where Applicant had not questioned its distinctiveness). However, Applicant has raised an issue with respect to the term GUARD alone. We also consider Applicant to have questioned the distinctiveness of the salient feature of Opposer's trade name, GUARD.

Applicant argues that GUARD "connotes protection, and therefore is descriptive of insurance services generally." 46 TTABVUE 12. Opposer, on the other hand, argues that the term GUARD is distinctive. 45 TTABVUE 21.

We take judicial notice of the dictionary definition of "guard," which means "a: the act or duty of protecting or defending" and "b: the state of being protected : PROTECTION."¹² Merriam-Webster Dictionary, <https://www.merriam-webster.com/dictionary/guard> (accessed February 16, 2022). In the context of insurance, GUARD suggests that insurance will protect the interests of the insured. Confirming the idea that insurance provides protection for the insured, Opposer's website includes the following statements related to its insurance products:

Professional Liability Insurance. Berkshire Hathaway Guard's Commercial Umbrella/Excess insurance ... gives an organization an additional tier of protection typically extending existing limits as well as financial security. Hartman declaration, exhibit K, 33 TTABVUE at 295.

¹² The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

Businessowners's Policies. Currently available in a select but rapidly growing number of states ... our policy helps protect the financial resources of small to mid-sized companies. Hartman declaration, exhibit K 33 TTABVUE 294.

For Workers Compensation and Employer's Liability coverage, Berkshire Hathaway GUARD writes policies from coast to coast for a wide variety of businesses ... While the protection offered by all insurers are largely dictated by government regulations, we distinguish ourselves from others in key ways. Hartman declaration, exhibit K 33 TTABVUE 293.

Protecting home, assets and peace of mind. Berkshire Hathaway Guard Homeowner's insurance products provide the traditional property and liability coverages needed by homeowners to protect their residence, assets, and overall way of life. Hartman declaration, exhibit K 33 TTABVUE at 299.

Professional liability insurance. "With lawsuits on the rise, professionals offering services of all kinds need protection . . . Berkshire Hathaway Guard's Professional Liability insurance has been designed to address the damages commonly incurred by wrongful acts ... Hartman declaration, exhibit K 33 TTABVUE 297.

We note that Opposer's marketing material, marketing flyers or brochures, shown below, provided in connection with Ms. Hartman's declaration testimony, use the term GUARD to suggest protection and to suggest Opposer's insurance services provide protection. Hartman declaration, Exhibit K, 33 TTABVUE 331, 332, 360. One of the brochures also states "[f]or over thirty years Guard has protected the interests of the small and medium sized business that insure with us." Hartman declaration, Exhibit K, 33. TTABVUE 362.

AmGUARD Insurance Company • EastGUARD Insurance Company • NorGUARD Insurance Company • WestGUARD Insurance Company

GUARD Your Business!

GUARD ...

- + your employees
- + your finances
- + your property
- + your fleet

... YOUR BUSINESS.



GUARD
INSURANCE
GROUP

OPP DOC 00078

AmGUARD Insurance Company • EastGUARD Insurance Company • NorGUARD Insurance Company • WestGUARD Insurance Company

Businessowner's Insurance

To see our operating area, visit our web site at www.guard.com.

**GUARD YOUR PROPERTY;
GUARD YOUR BUSINESS.**



Tailored to small- to mid-sized operations, Berkshire Hathaway GUARD's Businessowner's Policy helps you protect your financial resources. Our product offers:

- All the major business property and liability coverages.
- The availability of many specialized endorsements, including ones specifically targeted for artisan contractors, restaurants, professional offices, and retail and service establishments.
- Optional increased limits.
- The flexibility to customize your coverage to your unique circumstances.
- A variety of price discounts.

BizGUARD 

Comp • Businessowner's • Auto • Umbrella • Plus



Your Business Is Our Business

OPP DOC 00075

AmGUARD Insurance Company • EastGUARD Insurance Company • NorGUARD Insurance Company • WestGUARD Insurance Company

Workers' Compensation Insurance

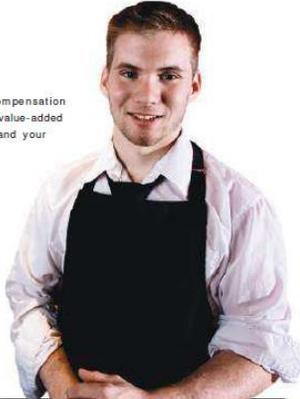
Available in the states highlighted below.



**GUARD YOUR EMPLOYEES;
GUARD YOUR BUSINESS.**

Berkshire Hathaway GUARD's Workers' Compensation insurance offers many flexible options and value-added services that can make your workplace safer and your bottom line stronger! For example ...

- Qualifying businesses can earn return premium as part of our *Dividend Programs*.
- A variety of payment options exist, including payroll billing.
- Our unique **GUARD Cooperative Care™** program offers customized loss control, medical management, subrogation, and fraud prevention strategies.



BizGUARD 

Comp • Businessowner's • Auto • Umbrella • Plus

Although GUARD is highly suggestive of insurance services, it is inherently distinctive as a mark or trade identity. *Two Pesos Inc. v. Taco Cabana Inc.*, 505 U.S.

763, 23 USPQ2d 1081, 1083 (1992) (suggestive, arbitrary and fanciful marks are deemed inherently distinctive).

“Oral testimony, if sufficiently probative, is normally satisfactory to establish priority of use in a trademark proceeding.” *Powermatics, Inc. v. Globe Roofing Prods. Co.*, 341 F.2d 127, 144 USPQ 430, 432 (CCPA 1965). *See also Nat’l Bank Book Co. v. Leather Crafted Prods., Inc.*, 218 USPQ 826, 828 (TTAB 1993) (oral testimony may be sufficient to prove the first use of a party’s mark when it is based on personal knowledge, it is clear and convincing, and it has not been contradicted).

Opposer’s witness provided uncontradicted testimony, supported by documentary evidence, about common law use of GUARDCO, GUARD E-Z RATE, AMGUARD INSURANCE COMPANY, EASTGUARD INSURANCE COMPANY, NORGUARD INSURANCE COMPANY, WESTGUARD, BIZGUARD PLUS,



and the “GUARD trademark” since the 1980s in connection with insurance services. Hartman declaration ¶ 16, 33 TTABVUE 5. Because all of these uses occurred before the August 18, 2016 filing date of Applicant’s application, Opposer has established prior common law rights in these marks.

As to Opposer’s use of GUARD as a trade identity, Opposer’s witness provided testimony and corroborating documentary evidence about Opposer’s use of GUARD, in connection with insurance services, as a salient feature of its trade name or as a shortened form of its trade name. Opposer’s witness testified that Opposer’s predecessors traded as AmGUARD Enterprises in 1982, changing to The GUARD Network by the mid-1980s. Hartman declaration ¶ 9, 33 TTABVUE 3-4 and exhibit

B, 33 TTABVUE 18-19. From 2000 to October 2012, Opposer traded as GUARD Insurance Group; from 2013 to the present it trades as Berkshire Hathaway GUARD Insurance Companies. Hartman declaration ¶ 9, 33 TTABVUE 3-4 and exhibit B, 33 TTABVUE 18-19. Opposer's witness testified about Opposer's use of its shortened company name GUARD, also providing documentary evidence of its self-reference as GUARD in marketing material. Hartman declaration ¶¶ 14, 15, 33 TTABVUE 265, 272, 279, 287, 335, 357-359. From the marketing material provided, there are two types of purchasers: the ultimate consumer, primarily small and mid-sized businesses, and insurance agents who Opposer markets to for agency appointments to offer its insurance products to the ultimate consumer. *See e.g., In re Engine Supply, Inc.*, 225 USPQ 216, 218 (TTAB 1985) (finding there are two types of purchasers, the ultimate consumer who is the automobile owner and the party who might buy one of applicant's rebuilt engines for the ultimate consumer).

Examples of Opposer's trade name use include the following:



We are proud to have joined the Berkshire Hathaway Group – and give you one more reason to consider requesting a GUARD agency appointment. Visit www.guard.com/apply or call 800-673-2465, ext. 4567!

A claim handled by GUARD will make the best of a bad situation. Employers and injured workers benefit from:

- › Expert adjusting;
- › Speedy processing;
- › Cost containment; and
- › Fast, fair resolutions.

Our state-of-the-art techniques are unique – the product of a quarter century of experience as a **workers' compensation specialist**. The proof of our expertise (*and the benefit to our agents*): high customer satisfaction AND policy retention!

GUARD FEATURES:

- Competitive pricing via a tiered rate structure.
- Flexible payment options.
- Safety groups for select classes.
 - Superior services, particularly in the area of claims.
 - Good income potential – attractive standard commissions plus profit sharing opportunity.
- A variety of easy ways to get a quote.
 - Fast turnaround; small business quotes receive same day (often same hour!) responses.
- Stability through good times and bad.

Safety Flyers

GUARD provides dozens of safety tips presented in an easy to use and understand manner. Topics range from "Basic Rules for Portable Power Tools" to "First Aid for Cuts and Wounds." Available in pdf format, these resources are also found via our PSC. A complete listing of titles is offered that can be viewed electronically or downloaded and printed. (Spanish versions are also provided.)

We find the Hartman testimony and corroborating documentary evidence is sufficient to establish Opposer's use in connection with insurance services of the term GUARD as a salient feature of Opposer's trade name and as a shortened form of Opposer's trade name prior to Applicant's priority date. *Bionetics Corp. v. Litton Bionetics, Inc.*, 218 USPQ 327, 330 (TTAB 1983) (priority of BIONETICS found based on trade name use showing BIONETICS was a salient feature of the prior-used trade names "Bionetics Research Laboratory" or "Litton Bionetics Inc."); *Mennen Company v. Yamanouchi Pharm. Co.*, 203 USPQ 302, 304 & 305 (TTAB 1979) (Board found MENNEN, the distinguishing feature of The Mennen Company trade name and MENNEN, used as a trademark, confusingly similar to MINON); *John R. Macgregor Lead Co. v. McGregor Coatings*, 146 USPQ 410, 412 (TTAB 1965) (evidence shows

that petitioner does use its trade name on labels and in its advertising; the record indicates that petitioner, to some extent, is known by the name “MacGregor Lead,” a shortened form of its trade name).

V. Likelihood of Confusion

We now turn our attention to likelihood of confusion. Our determination under Trademark Act Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (*Dupont*). In every likelihood of confusion analysis, two key factors are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence.

A. Family of Marks

We have determined that Opposer has prior use of marks containing the common element GUARD. “Neither the mere intention to create a family of marks, nor ownership of multiple registrations containing the family term, is sufficient in and of itself to establish that a party owns a family of marks.” *New Era Cap Co.*, 2020 USPQ2d 10596, at *7. Nor does simply using a series of similar marks of itself establish the existence of a family. *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932

F.2d 1460, 18 USPQ2d 1889, 1891-92 (Fed. Cir. 1991). Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family.

In determining whether a family of marks exist, we also must determine whether “the common characteristic is distinctive (i.e., not descriptive or highly suggestive or so commonly used in the trade that it cannot function as the distinguishing feature of any party’s mark)” and whether the marks that are claimed as a family, or at least a substantial number of them, were used and promoted together by the proponent in such a manner as to create public recognition coupled with an association of common origin predicated on the family feature. *See Truescents LLC v. Ride Skin Care, LLC*, 81 USPQ2d 1334, 1337-38 (TTAB 2006) quoting *Land-O-Nod Co. v. Paulison*, 220 USPQ 61, 65-66 (TTAB 1983) and *American Standard, Inc. v. Scott & Fetzer Co.*, 200 USPQ 457, 461 (TTAB 1978).

As stated above in our discussion of Opposer’s prior use and trade name use, the term “guard,” in the context of insurance services, is highly suggestive of protecting the interests of the insured. Although, as discussed infra, Applicant did not submit evidence of third-party use of “guard” in connection with insurance services, the dictionary definition of the word “guard” as well as Opposer’s own advertising shows that “guard” has a highly suggestive significance as applied to insurance products, casting some doubt on whether “guard” can be the basis for a family of marks claim. *See e.g., Logetronics, Inc. v. Logicon-Intercomp Inc.*, 199 USPQ 814, 818 (TTAB 1978) (“contention that it owns a family of marks is of no avail because the alleged root of

the family, ‘LogE’, has an admittedly highly suggestive connotation (the log of exposure) and also because ‘LOGIGRAPHIC’ does not fit into a family of ‘LogE’ marks”); *Ladish Co. v. Dover Corporation*, 192 USPQ 462, 464 (TTAB 1976) (citations omitted) (“the term “TRI” also has a descriptive or, at the least, highly suggestive meaning when used in connection with opposer’s goods, and it is therefore seriously doubted whether a family can be bottomed on proprietary rights assertedly acquired in such a common term”).

We consider whether there is sufficient recognition among the public of Opposer’s alleged family of marks with the GUARD feature. As indicated above, the relevant consumers are business owners seeking workers’ compensation insurance and insurance agents that may seek to carry Opposer’s lines of insurance. The determination that a family of marks exists is “generally predicated on the theory that, as a result of the extensive use and promotion of a group of marks each of which has a common component for a specific line of goods or services the relevant public has come to identify the source of these goods or services by the common features.” *Reynolds and Reynolds Co. v. I.E. Sys. Inc.*, 5 USPQ2d 1749, 1751 (TTAB 1987) (citing *Medical Modalities Assoc, Inc. v. ARA Corp.*, 203 USPQ 295, 301 (TTAB 1979)) *aff’d* 862 F.2d 321 (Fed.Cir. 1988) (unpublished table decision). *See e.g., McDonald’s Corp. v. McClain*, 37 USPQ2d 1274, 1275 (TTAB 1995) (finding widespread use and extensive promotion based on half a billion dollars spent in the United States as supporting family of marks claim). “[A]ny evidence pertaining to consumer reaction and exposure to the family is probative of the association of common ownership.” 7-

Eleven Inc. v. Wechsler, 83 USPQ2d 1715, 1719 (TTAB 2007) (citation omitted). See also *DAP, Inc. v. Flex-O-Glass, Inc.*, 196 USPQ 438, 443 (1976) (“The only way that this [the recognition of the family feature] can be ascertained is to place oneself in the position of a purchaser or prospective purchaser of [the plaintiff’s] products and attempt to understand just what would be the normal reaction to [the plaintiff’s] advertising and promotional material as it is encountered in the marketplace.”); *Witco Chem. Co. v. Chemische Werke Witten GmbH*, 158 USPQ 157, 160 (TTAB 1968) (“[we] look[] primarily to the nature and character of opposer’s advertising and promotional material” in determining whether a family of marks exists).

Opposer’s witness’ testimony relating to the promotion of its marks using the “distinctive naming strategy (GUARD + Descriptive Element)” lacks detail. The witness testified that “[t]he GUARD Marks (with GUARD used alone and also in connection with additional wording and images ...) are virtually always displayed with an emphasis on ‘GUARD,’ by depicting this wording in a different size, font and/or color to set it apart from any additional wording or images.” Hartman declaration ¶¶ 18, 20, 33 TTABVUE 7.

Examples include the following:

BizGUARD
Comp. Subcontractor's AAdv. Income Plus

Our *BOP* and other complementary lines are available in New Jersey, Pennsylvania, and New York and include:
Increased limits • Coverage extensions • Price discounts • Good income potential

GUARD now features a comprehensive insurance solution that offers the multiple lines of coverage typically needed by small- to mid-sized businesses. When your clients get both their Workers' Compensation and Businessowner's Policies from us, a special discount becomes available as well as consolidated billing. Call us to learn more about our underwriting appetite, which includes some coastal exposures.

To request an agency appointment, visit www.guard.com/apply OR call 800-673-2465, ext 4567.

AmGUARD Insurance Company • NorGUARD Insurance Company
P.O. Box A-H • 16 South River Street • Wilkes-Barre, Pennsylvania 18703 • (717)825-9900

GUARD INSURANCE GROUP
A- ("EXCELLENT") A.M. Best Rating

To learn more about our operations, we encourage you to contact any of these members of our marketing staff (pictured from left to right): Director of Marketing George Nackle; Field Representative Brian Klink; Marketing Analyst Tara McCormack; Marketing Secretary Cheryl Lupas; Marketing Coordinator Shawn Puchalski; and Field Representatives Bud Leister and Dave Tolerico.



AmGUARD • EastGUARD • NorGUARD Insurance Companies

Hartman declaration exhibit K, 33 TTABVUE 343, 365, 374, 381.

Opposer's witness testified that Opposer uses "online advertising, direct marketing, trade shows and industry conferences" to promote its marks. Hartman declaration ¶ 27, 33 TTABVUE 9. Ms. Hartman did not identify the nature of the specific type of advertising materials (e.g., print ad, brochure, flyer, webpages) submitted, nor indicate the dates the materials were distributed or circulated, nor indicate how often the materials were distributed or circulated.¹³ Many of the submissions are duplicative. For those materials that may be brochures or flyers, it is unclear where one brochure or flyer begins or ends. According to the brief, some of these pages are from Opposer's website. Some advertisements appear to be of a type that may have been placed in printed industry publications.

Most of the evidence Opposer has submitted does not support the family of marks claim. Some of the uses of AmGUARD, NorGUARD, EastGUARD, and WestGUARD together are buried in text or are in very small type at the top or bottom of the flyer. These uses are not prominent or easily noticeable to consumers or prospective

¹³ According to Opposer's brief, exhibit K consists of "Opposer's marketing and advertising materials, Opposer's website and website functionality, including insurance and policy information, login and claims services for individuals, as well as agents." 45 TTABVUE 9. The materials are undated but some materials show a date in the copyright notice, albeit some with dates subsequent to Applicant's priority date.

consumers. Many of the materials show only Opposer's current trade name, Berkshire Hathaway Guard Insurance Companies alone, or the trademark/trade name Guard Insurance Group alone. Others examples show one mark and the trade name Berkshire Hathaway Guard Insurance Companies, or the trademark/trade name GUARD Insurance Group and one other mark. Therefore, many of these materials do not show any use of all or even a significant number of the GUARD marks together. *See Econo-Travel Motor Hotel Corp. v. Econ-O-Tel of Am., Inc.*, 199 USPQ 307, 311-312 (TTAB 1978) (to establish a family of marks, it must be demonstrated through competent evidence that the various marks said to constitute the family, or a significant number of them, have become known to a particular segment of the purchasing public as a result of constant exposure through advertising and promotion to create an association with the common characteristic of the family) (citations omitted).

Three of these uses showing four marks together are the covers of insurance policies. Hartman declaration exhibit K, 33 TTABVUE 258-403. The listing of the various insurance companies on the policies may be viewed by the purchaser as simply listing all applicable insurance companies, as these insurance companies appear to offer their services in certain regions or states rather than nationwide. In any event, we do not know the level of distribution of the policies and the time period to show extensive exposure to relevant consumers, but even so, the initial distribution of a policy with the relevant disclosures and information to a consumer would not

establish constant exposure and conditioning of the consumer to view the marks as a family.¹⁴

There also are five undated advertising materials with three or four marks displayed together in a visible manner that appear to show acceptable family of mark use. Two of these uses appear to be older print advertisements, one directed to insurance agencies and one directed to businesses, showing GUARD INSURANCE COMPANY and design near AmGUARD and NorGUARD.¹⁵ There are also three flyers directed to businesses showing AmGUARD, NorGUARD, EastGUARD and WestGUARD visible at the bottom or top of the flyer, while a fourth flyer directed to insurance agencies lists the four insurance companies AmGUARD, NorGUARD, EastGUARD and WestGUARD at the bottom of the flyer. Hartman declaration Exhibit K, 33 TTABVUE 333-334, 343, 354, 363-364, 374, 381.

However, their probative value is limited in this case. Opposer's witness provided no information about the dissemination of the proffered advertising material, including its target audience, when it was circulated, and in what volume, so we have no testimony establishing constant and extensive use and promotion of the marks as a family. Therefore, we have no evidentiary basis for finding, on this record, that these materials were so extensively distributed to and widely encountered by

¹⁴ Another two of these submissions are letterhead and an envelope showing three marks but, again, we have no testimony about consumer exposure to these materials either.

¹⁵ The body of one of these advertisements references Opposer's performance in the years 1993-1994.

purchasers in the marketplace prior to Applicant's priority date to create in purchasers' minds a recognition of a family of marks.

We also note Opposer's witness testimony as to the expenditure of \$750,000 on advertising and promotion for the years 2015 through 2019, and \$3 million spent, during this same period, attending trade shows and industry conferences (that also includes expenditures for internal agent meetings and agent councils). Hartman declaration ¶¶ 29, 30, 33 TTABVUE 8. However, the majority of these expenditures are subsequent to Applicant's priority date. There is no testimony or other evidence at all as to advertising and promotional expenditures prior to 2015. Therefore, aside from the testimony not providing a sufficient breakdown of expenditures annually, nor describing the nature of the \$750,000 advertising and promotional expenditures, this evidence is insufficient to support establishment of a family of marks prior to Applicant's August 18, 2016 priority date.

The record fails to show that Opposer has widely used and extensively promoted together a significant number of its marks in such a manner to create public recognition of a GUARD family of marks. *Herman Miller, Inc. v. the Lane Co., Inc.*, 221 USPQ 922, 924 n.7 (TTAB 1984) ("there [must be] be sufficient promotional activity directed to the 'family' to establish in purchasers' minds that the family exists"); *Raypak, Inc. v. Dunham-Bush, Inc.*, 216 USPQ 1012, 1015 (TTAB 1983) ("the promotional activity must be sufficient in kind and intensity to establish in purchasers' minds a recognition or awareness of the existence of the family") (citations omitted).

We find therefore that Opposer has not established a family of marks.

Aside from the family of marks argument, it is clear from the record that Opposer's strongest bases for its Section 2(d) claim are its prior use of GUARD in connection with insurance services and its use of GUARD as a salient feature or shortened form of its trade name. Accordingly, we focus our analysis on these uses.

B. Similarity or Dissimilarity of the Services

We first consider the *DuPont* factor regarding the similarity or dissimilarity of the parties' respective services. *DuPont*, 177 USPQ at 567. We base our evaluation on the services as they are identified in Applicant's application and those services for which Opposer has established common law rights under the GUARD mark and shortened trade name. The services need only be "related in some manner or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source." *Coach Servs., Inc. v. Triumph Learning, LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (internal citations omitted). (citing *7-Eleven Inc. v. Wechsler*, 83 USPQ2d at 1724).

Applicant has argued that its services are different from Opposer's services based on its actual use; however, likelihood of confusion is based on the identification of the services in the application and not on actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citation omitted). In the context of likelihood of confusion, it is sufficient if likelihood of confusion is found with respect to use of the mark on any service that comes within the description of services in the application and those services for which Opposer has established common law use.

Hunter Indus., Inc. v. Toro Co., 110 USPQ2d 1651, 1661 (TTAB 2014) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) and *Apple Comput. v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007)).

Applicant argues that it provides completely different services than Opposer as “Opposer sells insurance Applicant does not and will not” and that “it does not sell [or purchase] insurance, but merely assists its sophisticated clients in analyzing insurance needs.” 46 TTABVUE 6, 12. Opposer argues that the documentary evidence submitted with witness testimony (and duplicated under notice of reliance) shows that it provides information in the field of workers’ compensation insurance, including policy rates and pricing, and that it provides advice and consulting as part of its sales and servicing process. 45 TTABVUE 24.

Applicant’s services are “Providing information in the field of workers’ compensation; Providing information regarding workers’ compensation insurance policy rates; Insurance consulting in the field of workers’ compensation insurance; Advising clients with respect to the purchase and cost of workers’ compensation insurance; Advising clients with respect to claims administration in the field of workers’ compensation insurance.”

Opposer’s documentary evidence that has been corroborated as being true and correct by Opposer’s witness indicates that it provides “secure, customizable coverage; competitive pricing and payment options; loss control strategies that can help prevent claims; techniques that can reduce the impact of the claims that do occur; and excellent service.” Hartman declaration exhibit K, 33 TTABVUE 330. In

particular, the corroborated “true and correct” documentary evidence indicates that Opposer provides:

Product information, pricing information, and information to help in reducing premiums:

- Provides product information relating to workers compensation including downloadable flyers on its website. Hartman declaration exhibit C and K, 33 TTABVUE 21, 271, 277.
- Uses discretionary pricing tools to provide competitive and affordable quotes. Hartman declaration exhibit K, 33 TTABVUE 330.
- Offers a free guide that provides the tools and direction needed to start a Return to Work program that can minimize the financial impact upon a business, and lower premium costs, by helping injured workers either stay on the job or return to work as quickly as medically advisable. Hartman declaration exhibit K, 33 TTABVUE 277.

Loss Control assistance:

- Provides staff that “assist[s] our policyholders in creating and maintaining safe operations and facilities—all in a cost-effective manner” and provides educational resources such as safety videos, safety flyers, workers’ comp loss control kits. Hartman declaration exhibit K, 33 TTABVUE 288.
- Offers Customized Workers’ Comp Service Plans for larger accounts that includes “schedule of consultations,” analysis of loss data, assistance in completing past recommendations, consultation in workplace safety practices, and assistance in setting up workplace safety awareness or formal safety programs. Hartman declaration exhibit K, 33 TTABVUE 288.

Claims Processing:

- Offers state-of-the-art software “to analyze data, offer guidance for mitigating the loss, expedite repairs and/ or medical treatment, and provide payments in a timely manner.” Hartman declaration exhibit K, 33 TTABVUE 288.
- Provides assistance for mitigating direct expenses on businesses from claims by offering distinct units for processing: medical only, early intervention, complex claims, property & liability, subrogation, fraud

investigative unit, medical bill repricing, and litigation team. Hartman declaration exhibit K, 33 TTABVUE 277, 288.

- Utilizes the resources of their Healthcare Management Affiliate for claims that involve medical treatment, “for purposes of quality care, cost containment, and a speedy return to normalcy for the injured party.” Hartman declaration exhibit K, 33 TTABVUE 288.
- Uses “preferred medical provider networks, telephonic case management, field case management / vocational rehabilitation, medical bill review, hospital audits, prescription drug management, and utilization review.” Hartman declaration exhibit K, 33 TTABVUE 288.
- When warranted, “work[s] closely with [third-party experts] emergency service vendors, attorneys, independent adjusters, appraisal services, and other insurance companies (such as Hartford Steam Boiler) to maximize our service levels and arrive at an appropriate claims resolution.” Hartman declaration exhibit K, 33 TTABVUE 288.

We find Opposer’s workers’ compensation insurance services are encompassed by Applicant’s broadly identified workers’ compensation insurance information, consulting, and claims administration advising services. *See S.W. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015) (where services are broadly identified, they are deemed to encompass all of the services of the nature and type described). Therefore, the services are at least legally identical in part.

The second *DuPont* factor weighs heavily in favor of likelihood of confusion.

C. Similarity or Dissimilarity of the Trade Channels

Opposer argues that the “legally presumed trade channels based upon Guard’s trademark registrations” and “Guard’s actual trade channels,” overlap with Applicant’s trade channels. 45 TTABVUE 25. Applicant argues that the channels of trade differ because Opposer uses brokers and agents while Applicant sells its services directly. 46 TTABVUE 12.

Since we are considering Opposer's common law rights in the GUARD mark and shortened trade name, there is no presumption about channels of trade in connection with insurance services. *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017) (no presumptions attach to unregistered common law mark). Opposer's channels of trade are limited to its common law uses. *Hard Rock Cafe Int'l (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1512 (TTAB 2000) (noting that opposer's channels of trade were limited to its common law uses).

Opposer's witness did not testify specifically as to trade channels, but some of the information contained in the marketing material, which Opposer's witness stated is true and correct, indicates that Opposer's distribution network is through independent insurance agencies located throughout the United States. Hartman declaration ¶ 18 Exhibit K, 33 TTABUE 268, 270. Opposer also offers quotes to consumers through its website. Hartman declaration ¶ 12 and exhibit C, 33 TTABVUE 4, 21.

In the application, Applicant's identification of services does not include any restriction as to trade channels, and we must presume that its services move in all normal and usual channels of trade and methods of distribution for those services and are available for purchase by all the usual purchasers. *See Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). We find there is some potential overlap in trade channels and business consumers who purchase workers' compensation policies, (discussed in more detail below), where the parties' services are legally identical and the identification of services in the

involved application has no restrictions on channels of trade or classes of consumers. See e.g., *Bell's Brewery*, 125 USPQ2d at 1345 (Board found that Applicant's unrestricted identification for beer will move in all channels of trade normal for such goods, which includes opposer's common law trade channels for beer). Accordingly, because of the potential overlap, the third *DuPont* factor supports a finding of a likelihood of confusion.

D. Conditions of Sale

The fourth *DuPont* factor considers the “conditions under which and buyers to whom sales are made.” *DuPont*, 177 USPQ at 567. The applicable standard of care for the likelihood of confusion analysis is that of the least sophisticated consumer. *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014).

Opposer's witness testified as to the truth and correctness of documentary evidence setting forth information about the consumers for Opposer's insurance services. Opposer's consumers are primarily small and mid-sized businesses that purchase workers' compensation insurance along with complementary property and liability lines, although Opposer does offer insurance to larger commercial accounts. Hartman declaration exhibit K, 33 TTABVUE 265-270. Opposer's consumers also include those who would purchase homeowners and personal liability insurance as it has recently expanded into these areas. Hartman declaration exhibit C and K, 33 TTABVUE 18, 269-270. Lastly, Opposer markets to insurance agencies for potential

“agency appointments” to carry its lines of insurance. Hartman declaration exhibit K, 33 TTABVUE 272-274.

Applicant’s consumers are businesses seeking information, advice and consultation about workers’ compensation insurance.

Applicant argues that consumers exercise greater care when purchasing insurance, referencing *Carefirst of Maryland, Inc. v. Firsthealth of the Carolinas, Inc.*, 77 USPQ2d 1492 (TTAB 2005) (recognizing that consumers “proceed cautiously and deliberately” in purchasing, e.g., healthcare insurance) and an unpublished Board case, *CDOC, Inc. v. Liberty Bankers Life Ins. Co.*, Opposition Nos. 91236945 and 91237330, slip op. (Jan. 16, 2020). 46 TTABVUE 7. Applicant submits that “businesses in this market do not make ‘impulse’ purchases.” 46 TTABUE 12.

Opposer, on the other hand, argues that this factor weighs in its favor as “[n]o careful or special consideration, or sophistication, is required to purchase the relevant insurance services” since this insurance is statutorily required. 45 TTABVUE 26.

We accept that at least some business consumers of insurance services will exercise heightened care, but as stated, we must base our decision on the least sophisticated potential purchasers. Because there is no evidence in the record that the least sophisticated purchasers for these services will exercise such a heightened degree of care, we find the fourth *DuPont* factor is neutral.

E. Strength of the Mark

We consider the extent of commercial strength or weakness in the marketplace under the fifth and sixth *DuPont* factors. *DuPont*, 177 USPQ at 567. Additionally, in

determining the strength of a mark, we consider inherent strength, based on the nature of the mark itself. *New Era Cap. Co.*, 2020 USPQ2d 10596, at *10; *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011).

1. Conceptual Strength

Applicant argues that GUARD is a weak term connoting protection and is “descriptive of insurance services generally” and that customers will be able to distinguish Applicant’s and Opposer’s marks because of the differences in the marks. 46 TTABVUE 10, 12.

We have already found, as discussed above, that Opposer’s common law mark GUARD and the salient feature of Opposer’s trade name, although inherently distinctive, are highly suggestive, and therefore weak conceptually.

2. Commercial strength

Opposer claims that its GUARD marks are famous as a family, also claiming the fame of its GUARD (a/k/a Berkshire Hathaway Guard Company) trade identity. 45 TTABVUE 29. Applicant, on the other hand, argues that Opposer is not a household name, that it has failed to provide probative evidence of fame, and that at best, any fame is “relative/modest.” 46 TTABVUE 11, 12. Because Opposer has not established that it has a family of marks, we consider whether GUARD as a mark/name is famous.

Commercial strength rests upon the extent to which “a significant portion of the relevant consuming public ... recognizes the mark as a source indicator.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison*

Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)). We assess the mark “along a spectrum from very strong to very weak.” *Id.* (internal citations omitted). At one end of the spectrum, a commercially stronger mark receives a wider latitude of legal protection in the likelihood of confusion analysis. *See Palm Bay Imps.*, 73 USPQ2d at 1694. By contrast, “the weaker an opposer’s mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (citation omitted).

Commercial strength may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods or services sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods identified by the marks; and the general reputation of the goods or services. *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014); *see also Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1308 (Fed. Cir. 2002) (recognizing indirect evidence as appropriate proof of strength). On the other hand, marketplace weakness can be shown by evidence of the extensive registration and use of a term by others. *Juice Generation*, 115 USPQ2d at 1674-75; *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135-36 (Fed. Cir. 2015).

As indicated above, Opposer's purchasers are of two types: businesses seeking workers' compensation insurance, and insurance agents who Opposer markets to for agency appointments to carry its insurance products. Opposer's witness provided information about Opposer's premium revenues and advertising and promotional activities. Most of the testimony is directed to its workers' compensation insurance business, and from the submissions and testimony provided, it appears most of its marketing is directed to those in the insurance industry rather than to the public at large.¹⁶

We find this evidence is directed to niche market fame. *See ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351, 1358 (TTAB 2007). Opposer's witness did not address any specific marks in her testimony, referring generally to "GUARD marks," as well as Opposer's self-reference to its shortened trade name GUARD:

- Opposer has been in the insurance industry for 39 years, with a heavy focus on workers' compensation from 1982 to 2008. Hartman declaration ¶¶ 9-11, 33 TTABVUE 3-4.
- In 2019, revenues exceeded \$1.8 billion, with approximately \$880 million directly attributable to workers' compensation policies. Hartman declaration ¶ 25, 33 TTABVUE 8.
- As of 2019, according to Best Market Share Reports submitted with the Hartman declaration testimony, Opposer has a 4.05% market share for direct premiums written in the workers' compensation market. According to this report, listing thirty insurers, Opposer is number six on this report. Hartman ¶ 35, 33 TTABVUE 10.

¹⁶ The majority of the advertising material provided at Exhibit K in the Hartman declaration at ¶ 18, 33 TTABVUE 7 is directed to insurance agencies, although Opposer has highlighted in its brief those few that are directed to businesses, including one that references the BIZGUARD PLUS insurance product. Hartman declaration exhibit K, 33 TTABVUE 258-403. We have already discussed in the family of marks section how Opposer's GUARD trade name/trademarks are displayed in the marketing materials and whether they have impact on the public.

- From 2015 to 2019, Opposer’s network of agents has grown from 3,100 to 6,200. Hartman declaration ¶ 34, 33 TTABVUE 10.
- From 2010 through 2019, direct written premium volume has increased in the range of 22%-34% each year. Hartman declaration ¶ 26, 33 TTABVUE 8.
- From 1983 through the end of 2019, Opposer sold in excess of 1.4 million workers’ compensation-specific policies. Hartman declaration ¶ 24, 33 TTABVUE 8.
- In 2015, Opposer sold 107,000 workers’ compensation policies. Hartman declaration ¶ 24, 33 TTABVUE 8.
- In 2018, Opposer sold 158,000 workers’ compensation policies. Hartman declaration ¶ 24, 33 TTABVUE 8.
- In 2019, Opposer sold 136,000 workers’ compensation policies. Hartman declaration ¶ 24, 33 TTABVUE 8.
- From 2015 to 2019, Opposer spent nearly \$750,000 on advertising and promotion involving its GUARD Marks, which includes featuring its advertising in insurance industry printed and electronic publications. Hartman declaration ¶¶ 29, 28, 33 TTABVUE 9.
- From 2015 to 2019, Opposer spent nearly \$3 million attending trade shows (small-scale local, large-scale industry, and annual), attending industry conferences, and hosting its internal annual advisory council meetings and Agent Meetings (industry updates, getting feedback from its agents to continually improve offerings, and offering direct support to its agents). Hartman declaration ¶ 27, 33 TTABVUE 8-9.
- From 2015 to 2019, Opposer increased the number of state-specific and nationwide insurance industry associations of which it is a member (from 25 to 49). Hartman declaration ¶ 33, 33 TTABVUE 10.
- In 2020, 2019 and 2016, Opposer achieved AM Best Company, Inc.’s A+ financial strength rating and a long-term issuer credit rating of “aa-.” Hartman declaration ¶ 38, 33 TTABVUE 11.
- Opposer was named a Ward’s 50 Top Performer in 2012 in connection with financial performance. Hartman declaration ¶ 38, 33 TTABVUE 11.

Opposer's testimony and its confidential exhibit shows that it has had recent success (2013-2016 period and through 2020) in rapidly growing its workers' compensation business of direct premiums written and its network of agents. According to the witness testimony and submitted market shares report, Opposer is sixth in the market for issuing workers' compensation policies. Opposer's confidential exhibit D, which we mention generally, shows expansion in the number of lines of business, and steady increases in agents, policies issued, and premium revenue between the periods: 1983-2006, 2007-2012, 2013-2016, and 2017-2020. Hartman declaration exhibit D, 34 TTABVUE.

As to Opposer's advertising and promotional expenditures, as already stated, we do not have a breakdown of annual expenditures for the years 2015-2019, but the \$750,000 figure is very low when considering Opposer's market share. The information provided by Opposer's witness also lacks context as to how these figures compare with other insurers advertising workers' compensation insurance, making the information less probative. *See Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1408 (TTAB 2009) (opposer's advertising figures were "not particularly impressive" and "the problem that we have in assessing the effectiveness of the advertising expenditures is that there is no testimony or evidence regarding whether opposer's advertising expenditures are large or small vis-à-vis other comparable medical products."). Although "market share is but one way of contextualizing ad expenditures or sales figures," *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1690 (Fed. Cir. 2018) (citing

Bose, 63 USPQ2d at 1309), Opposer’s modest advertising figures are nowhere close to the figures in cases in which marks have been found to be famous under Section 2(d), and therefore “some context in which to place [opposer’s] raw statistics is reasonable,” *Bose*, 63 USPQ2d at 1309. We find the \$750,000 advertising and promotional figure does not buttress the claim that Opposer’s mark is on the high end of the commercial strength spectrum.

Opposer attends a large number of trade shows (2015 136; 2016 164; 2017 165; 2018 170; and 2019 196) but the size of these trade shows varies from small local events to large industry events, and the extent of consumer exposure is unclear as we have no attendance figures.¹⁷ We also do not know if Opposer acts as an exhibitor or an attendee at these events. As to industry conferences, Opposer has provided a representative list of events for 2019, most of which appear to be meetings, conferences or conventions, but we have no information about Opposer’s role at these conferences (i.e., as an attendee, speaker, or exhibitor). We also have no specific attendance information at industry events for years prior to 2019. The actual amount spent on trade show attendance and industry conferences and meetings for the period 2015 through 2019 is unclear from witness testimony because Opposer combined these figures with attendance expenses related to internal in-house agent and internal advisory council meetings. As to Opposer’s consistent and increased memberships in state and nationwide insurance associations, Opposer’s witness did

¹⁷ The majority of these listed in Exhibit are directed to insurance agent/agencies. Hartman declaration exhibit N, 33 TTABVUE 409-410.

not provide any specifics as to how its memberships increased its GUARD mark or trade name marketplace exposure.

As to Opposer's advertising in industry publications "of its GUARD marks," Opposer made of record a list of publications for 2018-2019, but corresponding circulation figures were not made of record, and the record does not contain any information about advertising in these publications prior to 2018. *See Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1042 (TTAB 2010) (Board could not infer fame of mark mentioned in university-sponsored reports, studies, articles and press releases in the absence of evidence of their circulation). Opposer's witness did not provide any specifics about its online advertising or other direct marketing efforts.

Opposer's witness also testified that its "impressive growth" is "much discussed" and that it has received "widespread recognition" in the insurance field. Hartman declaration ¶ 13, 33 TTABVUE 4. However, the evidence referenced, eliminating duplicates, identifies only two articles discussing Opposer's growth, while three other stories relate to Opposer's business activities. This evidence is insufficient to establish widespread recognition relating to Opposer's workers' compensation insurance services.

Lastly, the witness also testified that "GUARD" was a Ward Top 50 performer in 2012 in connection with financial performance and provided testimony relating to ratings improvement to an A+ rating by AM Best. However, financial strength (as opposed to sales/revenues) or financial performance is not necessarily indicative of consumer recognition.

As indicated, evidence of use of similar marks by third parties for the same or similar goods or services also is relevant to a mark's commercial strength. *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017); *Juice Generation*, 115 USPQ2d at 1674.

Applicant asserts, without supporting evidence, that “multiple insurance companies utilize the word ‘GUARD’ in the sale of insurance, and have registered marks utilizing this term.” 46 TTABVUE 12. Applicant also merely argues without evidence that “the USPTO has approved applications for multiple marks utilizing the descriptive word ‘GUARD’ in connection with insurance-related services.” 46 TTABVUE 10. Applicant contends that in likelihood of confusion cases involving related, but different products or services, courts have found that various marks that contain the term GUARD are not similar, but the two referenced cases do not involve insurance services. 46 TTABVUE 10, 13. Applicant also argues that Opposer should not be able to bar others from utilizing the word “guard.” 46 TTABVUE 12.

Opposer, on the other hand, argues that the sixth *DuPont* factor is in its favor as “Applicant did not submit any evidence of third-party similar marks for similar services.” 45 TTABVUE 29.

Applicant did not submit any evidence as to marketplace weakness, and Applicant's attorney argument does not constitute evidence. *See Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005) (“Attorney argument is no substitute for evidence”). While our determination as to marketplace

weakness might very well be different on a different record, here, Applicant has not established that there is commercial weakness of the term GUARD.

3. Conclusion as to Strength

Considering as a whole the record pertaining to the fifth and sixth *DuPont* factors, we find that although GUARD is conceptually weak, it is commercially strong.

F. Similarity or Dissimilarity of the Marks

The first *DuPont* factor considers the similarity or dissimilarity of Opposer's GUARD mark/name to Applicant's mark. The Board considers the marks "in their entireties as to appearance, sound, connotation and commercial impression." *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *DuPont*, 177 USPQ at 567). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods or services offered under the respective marks is likely to result. *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977).

Although marks must be considered in their entireties, "in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). "In general, disclaimed or descriptive terms are considered less

significant features of the mark.” *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997).

As we have noted, we consider the similarity of the marks based on Opposer’s prior adoption and use of GUARD as a mark and based on its use of GUARD as the salient feature or shortened form of its trade name. Applicant’s mark is in standard characters while Opposer’s GUARD mark/name has been displayed in slightly stylized form with GUARD emphasized. Although Opposer’s common law rights are for the mark/name as actually used, which has a slight stylization, Applicant’s mark is in standard characters, and therefore may be used in the same stylization. *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011) (standard character registrations “are federal mark registrations that make no claim to any particular font style, color, or size of display and, thus, are not limited to any particular presentation,” citing 37 C.F.R. § 2.52).

Applicant’s mark is WORKERSCOMP GUARD and includes a disclaimer of the term WORKERSCOMP. Therefore, GUARD is the dominant element in Applicant’s mark. The term GUARD in Applicant’s mark is identical in appearance, sound, meaning and commercial impression to Opposer’s GUARD mark/name.

When we compare Applicant’s mark in its entirety to Opposer’s GUARD mark/name, we find they are similar in appearance and sound. Applicant has taken Opposer’s entire mark/name GUARD and added the disclaimed, and admittedly descriptive, if not generic, term WORKERSCOMP to it.

With regard to meaning or connotation, WORKERSCOMP GUARD suggests insurance services that offer protection in connection with workers compensation while Opposer's GUARD mark and the shortened trade name suggest insurance services that protect persons or property, or a business. Indeed, GUARD is highly suggestive of insurance generally, including worker's compensation insurance and conceptually weak. The addition of the term WORKERSCOMP to Applicant's mark gives a more specific meaning to the GUARD portion of Applicant's mark and provides a similar connotation.

Although in cases where a term in a mark is highly suggestive, we may find that purchasers are able to distinguish the marks by looking to other elements, *see e.g., Murray Corp. of Am. v. Red Spot Paint and Varnish Co., Inc.*, 126 USPQ 390, 392-393 (CCPA, 1960) (EASY and EASYTINT for paints found not confusingly similar where third-party registrations and trademark directory indicated that "easy" is suggestive in connection with paints and "tint" was a descriptive term for paints); *In re Huncke & Jocheim*, 185 USPQ 188, 189 (TTAB 1975) ("...the addition of other matter to a highly suggestive or descriptive designation, whether such matter be equally suggestive or even descriptive, or possibly nothing more than a variant of the term, may be sufficient to distinguish between them so as to avoid confusion in trade"), that is not the record we have before us. We find the marks engender sufficiently similar overall commercial impressions.

Lastly, Opposer's ownership of various marks with the term GUARD increases the likelihood that Applicant's mark WORKERSCOMP GUARD would be perceived

as an additional variation of Opposer's GUARD formative marks as used in connection with insurance services. *Cf. See Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1700 (TTAB 1987) ("The fact that Humana has itself used variations of its house mark by adding matter to it, e.g. HUMANA CARE and HUMANA CARE PLUS, increases the likelihood that HUMANOMICS would be perceived as another variation. We do not consider the above to be a 'family of marks' result").

GUARD on its face is highly suggestive and inherently weak, and may therefore be expected to be in widespread use by third parties. On a different record, we might find that third-party use lessens the scope of protection entitled to Opposer's mark such that the addition of WORKERSCOMP to Applicant's mark is sufficient for consumers to distinguish the marks. However, we are constrained to find on this record that the addition of the term WORKERSCOMP is not sufficient to distinguish Applicant's mark from Opposer's GUARD mark or shortened trade name. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) ("Viewed in their entireties with non-dominant features appropriately discounted, the marks [GASPAR'S ALE for beer and ale and JOSE GASPAR GOLD for tequila] become nearly identical"); *Bellbrook Dairies, Inc. v. Hawthorn-Mellody Farms Dairy, Inc.*, 253 F.2d 431, 117 USPQ 213, 214 (CCPA 1958) ("SLIM" and "VITA-SLIM" confusingly similar where SLIM is the dominant part of the mark, VITA disclaimed).

We find the marks are similar, and the first *DuPont* factor weighs in Opposer's favor.

G. Seventh and Eight *DuPont* Factors

The seventh *DuPont* factor is “the nature and extent of any actual confusion” and the eighth *DuPont* factor is “the length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 177 USPQ at 567.

Opposer argues that the seventh *DuPont* “factor is neutral and essentially inapplicable” because any use is “minimal and recent.” 45 TTABVUE 30. Applicant argues that there has been no confusion noting that “Applicant has been utilizing the “WorkersComp Guard” mark in commerce, via its website, for approximately four years.”

However, the absence of any reported instances of actual confusion would be meaningful only if the record indicated appreciable and continuous use by Applicant of its mark for a significant period of time in the same markets as those served by Opposer under its marks. Other than attorney argument, Applicant in this case has failed to present any evidence of the extent and duration of its use of its mark. *See Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

We find that because there has been no significant opportunity for actual confusion to have occurred, these *DuPont* factors are neutral.

H. Ninth *DuPont* factor

The ninth *DuPont* factor requires us to consider “the variety of goods on which a mark is or is not used.” *DuPont*, 177 USPQ at 567. Opposer argues that this factor falls in its favor because it offers a “broad range of services, covering essentially all

core insurance industry services” while Applicant argues its mark is “utilized on insurance-related consulting and risk management services, whereas Opponent’s marks are utilized on actual insurance policies.” 45 TTABVUE 32; 46 TTABVUE 13.

Although Opposer does use GUARD composite marks on a variety of insurance underwriting and some associated services, inasmuch as they are all are centered on insurance services, we find this *DuPont* factor is neutral.

I. Tenth *DuPont* Factor

The tenth *DuPont* factor requires us to consider evidence pertaining to “the market interface” between the parties, including evidence of any past dealings between the parties which might be indicative of a lack of confusion in the present case. *DuPont*, 177 USPQ at 567. Much of Opposer’s argument addresses the general marketing environment, which is not a consideration under this factor. Opposer also argues that it “has not provided Applicant with any consent to use” and “[t]here are no agreements or other mitigating limitations to use in place.” 45 TTABVUE 31. Applicant argues that the market interface “would be limited.” 46 TTABVUE 13.

Because there is no consent to use or other agreement between the parties, this *DuPont* factor is neutral.

J. Eleventh *DuPont* Factor

Opposer argues that “substantially exclusive registration and use provides Guard with broad rights to exclude others from use and registration.” 45 TTABVUE 31. Presumably, Opposer is arguing the eleventh *DuPont* factor, “the extent to which applicant has a right to exclude others from use of its mark on its goods.” *DuPont*,

177 USPQ at 567. Applicant argues that “it does not seek to exclude others” except in combination with its involved mark. 46 TTABVUE 13.

This factor requires us to consider evidence pertaining to Applicant’s right to exclude others from use of its mark, not Opposer’s right to exclude others. There is no such evidence in the record with respect to Applicant. Therefore, the eleventh *DuPont* factor is neutral in this case.

K. Twelfth *DuPont* Factor

The twelfth *DuPont* factor is intended to address whether the potential for confusion is “de minimis or substantial.” *DuPont*, 177 USPQ at 567.

Opposer argues the potential for confusion is substantial due to the similar marks, services, trade channels and classes of consumers. 45 TTABVUE 32. Applicant argues “Opposer has not articulated a plausible basis for potential confusion.” 46 TTABVUE 13.

We find the extent of potential confusion is not de minimis, and this *DuPont* factor favors Opposer.

L. Thirteenth *DuPont* Factor

Opposer argues that Opposer’s “prior registrations, Guard’s penetration in the industry, and Applicant’s continued pursuit of its application, speaks volumes about Applicant’s bad intent.” 45 TTABVUE 32. Applicant argues that “Opposer has not articulated any other facts relevant to this analysis.” 46 TTABVUE 13.

“Under the thirteenth *DuPont* factor, evidence of Applicant’s bad faith adoption of [its] mark is relevant to our likelihood of confusion analysis.” *L.C. Licensing Inc. v.*

Berman, 86 USPQ2d 1883, 1890 (TTAB 2008) (citing *J & J Snack Foods Corp. v. McDonald's Corp.*, 8 USPQ2d at 1891 (“Whether there is evidence of intent to trade on the goodwill of another is a factor to be considered, but the absence of such evidence does not avoid a ruling of likelihood of confusion.”))).

An applicant’s prior knowledge of an opposer or its marks is not, in itself, sufficient to constitute bad intent. *See Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987). A finding of bad faith must be supported by evidence of an intent to confuse, rather than mere knowledge of another’s mark or even an intent to copy. *See Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769, 1782 (2d Cir. 2009) (“[T]he ‘only relevant intent is intent to confuse. There is a considerable difference between an intent to copy and an intent to deceive.’” (quoting MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:113)).

Inasmuch as Opposer’s argument appears to relate to Applicant’s knowledge of Opposer and its registrations, and not to Applicant’s intent, we find this *DuPont* factor to be neutral.

VII. Conclusion

We have considered all of the evidence pertaining to the relevant *DuPont* factors, as well as the parties’ arguments with respect thereto. While on a different record, we might find no confusion given the highly suggestive nature and inherent weakness of the term GUARD, here we find that the similarities between Opposer’s common law mark and shortened trade name, GUARD, and Applicant’s mark,

WORKERSCOMP GUARD, the legally identical nature of at least some of the services, and overlapping trade channels make confusion likely.

Decision: Opposition No. 91234475 is sustained on the basis of likelihood of confusion and registration to Applicant's application Serial No. 87142642 is refused.